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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,766	01/02/2002	Jeffery Tabor	659/919	6310

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,766

Applicant(s)

TABOR ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9 and 11-21 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasure et al. (US Patent No. 5,025,910).

Lasure discloses a transfer assembly for transporting and applying a discrete part (11) to a moving web (14). The assembly includes a carrier body having a discrete part engaging outer surface (33), the outer surface including is generally convex (See Figures 6 and 7). The surface is adapted and configured to engage the discrete part (11) and comprises at least one aperture (54) in said outer surface and extending through the carrier body for communication with a vacuum source (15). The apertures (54) in Lasure amount to recessed portions adapted and configured to engage at least a portion of the part. These recess portions would be considered to be generally convex because they occur on a convex surface.

Regarding claim 2, recessed portions are located centrally in Lasure.

Regarding claim 6, Lasure includes a base for carrying the carrier body.

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3. Claims 9 and 11-14 are rejected under 35 U.S.C. 102(a) as being anticipated by McCabe et al. (US Patent No. 6,482,278 B1).

McCabe discloses an apparatus for applying discrete parts onto a substrate web, the apparatus comprising a web conveyor (12) adapted to support and advance a substrate web and a transfer assembly (44) generally convex in shape and configured to rotate about an axis and which includes an outer surface configured to engage a discrete part. The transfer assembly (44) is spaced from the web conveyor such that the discrete part may be applied to the substrate web and the outer surface of the transfer assembly (44) includes at least one recessed portion for engaging at least one portion of the discrete part. The recessed portion is not shown in McCabe, however the transfer assembly (44) is a vacuum head (44) which is well known in the art to include vacuum holes. These holes amount to a recess portion as required by the claim.

Regarding claim 11, the web conveyor and the transfer assembly are capable of being spaced apart a distance less than the combined total thickness of the substrate web and the discrete part to ensure the discrete part contact the web as the transfer assembly rotates.

Regarding claims 12-14, McCabe meets the limitations of these claims.

4. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ujimoto et al. (US Patent No. 4,943,340).

Ujimoto discloses a transfer assembly (12) configured to rotate about an axis and which includes an outer surface configured to engage the discrete parts (7) cut from a sheet (77). Ujimoto also includes conveyor (21a, 21b) having an outer surface capable of supporting and advancing a substrate web. The space between the conveyor belts (21a, 21b) is a recessed area which engages the parts (7).

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Regarding claim 16, the conveyor and the transfer assembly are capable of being spaced apart a distance less than the combined total thickness of the substrate web and the discrete part to ensure the discrete part contact the web as the transfer assembly rotates.

5. Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshefsky et al. (US Patent No. 4,578,133).

Oshefsky discloses a web (24a) conveyor with a rotating transfer assembly (36) with transfer means (30) for transferring elastics (16, 18). The transfer means include flexible strip supports (32) to which the self-adhering elastic strip material will adhere sufficiently for purposes of the invention and from which the elastic strips can be removed for transfer to web of material as described below. Alternatively, Oshefsky discloses that other suitable methods may be employed to temporarily adhere the elastic strips to the flexible strip supports, such as a vacuum which may be supplied to openings on the top surface of flexible strip supports (32) to hold the elastic strips in place. If a vacuum were used, the openings discussed would amount to a recessed portion. The embodiment of Figure 5B shows the transfer members rotating about a second axis. The pivoting supports (48) are adapted to move along a curvilinear path on a cam track (60). (Col. 7, lines 25-55; Col. 9, lines 3-65.)

Regarding claims 18 and 19, the device in Oshefsky is capable of maintaining a constant speed. Intended use recitations and other types of functional language cannot be entirely disregarded. However, in apparatus claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re*

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Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 20, Oshefsky includes a turning mechanism capable of rotating at least one transfer assembly before the discrete parts are applied to the substrate.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lasure as applied to claim 1 above.

Lasure does not disclose the shape of the recess portions. Typical vacuum apertures are round, however rectangular holes or slots are known and generally known in the art.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use rectangular holes or slots in Lasure, depending on the material that is being picked up by the vacuum source.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasure as applied to claim 1 above, and further in view of Booth et al. (US Patent No. 5,579,340).

Lasure does not discuss a surface roughness for the outer surface of the vacuum shoes (33) or a plasma coating.

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Booth discloses using a transfer segment with an outer surface roughness of at least 3 micrometers. As a result, a relatively low level of vacuum may be drawn through holes in the outer surface (46) to assist the surface roughness in maintaining the elongated elastic parts (26) in the elongated state. To achieve the surface roughness, the outer surface (46) of each transfer segment may include a coating such as a plasma coating as are known to those skilled in the art. (Col. 6, lines 23-53.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shoes in Lasure include a surface roughness as taught by Booth, because a surface roughness assists in gripping the article on the surface and thus less vacuum pressure would be needed to hold the article in place. Furthermore, Booth teaches that it is within the purview of the artisan to use a plasma coating to achieve a surface roughness.

Response to Arguments

9. Applicant's arguments with respect to claims 1-4, 6-9, and 11-21 have been considered but are moot in view of the new grounds of rejection.

10. Applicant's arguments filed 08 January 2004 with respect to claims 17-20 have been fully considered but they are not persuasive.

11. Applicant states that claim 17 recites that "the recessed portion is part of the outer surface" and it "receive[s] or engages part of the discrete part." Applicant then goes on to argue that "[i]n contrast, the vacuum supplying openings in the top surface of one of the flexible strips, as disclosed in Oschefskey ... do not make up any part of the outer surface and are not capable of engaging or supporting any material, but rather necessarily extend into the flexible strip and communicate with a vacuum supply." The examiner disagrees that the openings do not make up any part of the outer surface and the holes are designed to

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engage the material to hold it in place during transfer. The holes presence on the outer surface is an indication that they are a part of the applicator surface. There is no indication that they "extend into the flexible strip" as set forth by the applicant. Oschefskey clearly states that "vacuum may be supplied to openings on the top surface of flexible strip supports (32) to hold the elastic strips in place." (Col. 7, lines 52-54.) Applicant goes on to argue that "instead of making up a portion of the outer surface, they provide a void in the outer surface." Examiner's position is that the "void" is a recess as required by the claim.

12. Applicant sets forth an indication of the "recessed portion" in the specification, however, on page 3, lines 5-13 of the specification sets forth the following:

Each transfer assembly includes an outer surface configured to engage a discrete part. The outer surface of the transfer assembly is spaced from the web conveyor such that the discrete part may be applied to the substrate web. The outer surface includes one or more recessed portions for engaging at least one portion of the discrete part that is relatively thicker than other portions of the discrete part.

Given this language, and no showing of an embodiment where more than one "concaved" or "recessed portion" exists in a single transfer assembly in the specification. The examiner interpreted the terminology "recessed portion" broadly to include recesses in the surface which allow for vacuum to be communicated, because in this environment, those form of recesses are quite common. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

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Allowable Subject Matter

13. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is an examiner's statement of reasons for allowance: Claim 3 sets forth clearly that the "recessed portion" is like the embodiment shown in Figure 3. There is no reason to have a vacuum hole be in the shape of an hour glass as required by the claim.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Sue A. Purvis", with a long horizontal line extending to the right.

Sue A. Purvis
Examiner
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SP
April 5, 2004